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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/758,980	01/16/2004	Monty Boyer	60072-0928	7920

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EXAMINER

COULTER, KENNETH R

ART UNIT	PAPER NUMBER
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2141

DATE MAILED: 05/18/2006

Please find below and/or attached an Office communication concerning this application or proceeding.

Office Action Summary

Application No.

10/758,980

Applicant(s)

BOYER ET AL.

Examiner

Kenneth R. Coulter

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– The MAILING DATE of this communication appears on the cover sheet with the correspondence address –
Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☐ Responsive to communication(s) filed on ____.
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 1-44 is/are pending in the application.
- 4a) Of the above claim(s) ____ is/are withdrawn from consideration.
- 5) ☐ Claim(s) ____ is/are allowed.
- 6) ☒ Claim(s) 1-44 is/are rejected.
- 7) ☐ Claim(s) ____ is/are objected to.
- 8) ☐ Claim(s) ____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☒ The drawing(s) filed on 16 January 2004 is/are: a) ☒ accepted or b) ☐ objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some * c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
 2. ☐ Certified copies of the priority documents have been received in Application No. ____.
 3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- | | |
|--|---|
| 1) <input checked="" type="checkbox"/> Notice of References Cited (PTO-892) | 4) <input type="checkbox"/> Interview Summary (PTO-413)
Paper No(s)/Mail Date. ____. |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948) | 5) <input type="checkbox"/> Notice of Informal Patent Application (PTO-152) |
| 3) <input checked="" type="checkbox"/> Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08)
Paper No(s)/Mail Date <u>5/18/04</u> . | 6) <input type="checkbox"/> Other: ____. |

DETAILED ACTION

Claim Rejections - 35 USC § 101

1. 35 U.S.C. 101 reads as follows:

Whoever invents or discovers any new and useful process, machine, manufacture, or composition of matter, or any new and useful improvement thereof, may obtain a patent therefor, subject to the conditions and requirements of this title.

2. Claims 1 – 30 are rejected under 35 U.S.C. 101 because the claimed invention is directed to non-statutory subject matter.

Independent claims 1, 9, 14, and 23 are directed to software (instructions) that is not implemented on a computer-readable **storage** medium.

Data structures not claimed as embodied in computer-readable media are descriptive material *per se* and are not statutory because they are not capable of causing functional change in the computer. See, e.g., *Warmerdam*, 33 F.3d at 1361, 31 USPQ2d at 1760 (claim to a data structure *per se* held nonstatutory). Such claimed data structures do not define any structural and functional interrelationships between the data structure and other claimed aspects of the invention which permit the data structure's functionality to be realized. In contrast, a claimed computer-readable medium encoded with a data structure defines structural and functional interrelationships between the data structure and the computer software and hardware components which permit the data structure's functionality to be realized, and is thus statutory.

Double Patenting

3. The nonstatutory double patenting rejection is based on a judicially created doctrine grounded in public policy (a policy reflected in the statute) so as to prevent the unjustified or improper timewise extension of the "right to exclude" granted by a patent and to prevent possible harassment by multiple assignees. A nonstatutory obviousness-type double patenting rejection is appropriate where the conflicting claims are not identical, but at least one examined application claim is not patentably distinct

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from the reference claim(s) because the examined application claim is either anticipated by, or would have been obvious over, the reference claim(s). See, e.g., *In re Berg*, 140 F.3d 1428, 46 USPQ2d 1226 (Fed. Cir. 1998); *In re Goodman*, 11 F.3d 1046, 29 USPQ2d 2010 (Fed. Cir. 1993); *In re Longi*, 759 F.2d 887, 225 USPQ 645 (Fed. Cir. 1985); *In re Van Ornum*, 686 F.2d 937, 214 USPQ 761 (CCPA 1982); *In re Vogel*, 422 F.2d 438, 164 USPQ 619 (CCPA 1970); and *In re Thorington*, 418 F.2d 528, 163 USPQ 644 (CCPA 1969).

A timely filed terminal disclaimer in compliance with 37 CFR 1.321(c) or 1.321(d) may be used to overcome an actual or provisional rejection based on a nonstatutory double patenting ground provided the conflicting application or patent either is shown to be commonly owned with this application, or claims an invention made as a result of activities undertaken within the scope of a joint research agreement.

Effective January 1, 1994, a registered attorney or agent of record may sign a terminal disclaimer. A terminal disclaimer signed by the assignee must fully comply with 37 CFR 3.73(b).

4. Claims 1 – 44 are rejected on the ground of nonstatutory obviousness-type double patenting as being unpatentable over claims 1 – 22 of U.S. Patent No. 6,711,609. Although the conflicting claims are not identical, they are not patentably distinct from each other because of the following mapping.

Claim 1 of the present Application maps to claims 1, 6, and 15 of '609.

Claim 2 of the present Application maps to claim 2 of '609.

Claim 3 of the present Application maps to claims 1, 2, and 4 of '609.

Claim 4 of the present Application maps to claims 1 – 5 of '609.

Claim 5 of the present Application maps to claims 1, 2, and 4 of '609.

Claim 6 of the present Application maps to claims 1, 3, 4, and 5 of '609.

Claim 7 of the present Application maps to claims 1, 3, 4, and 5 of '609.

Claim 8 of the present Application maps to claims 1 and 4 of '609.

Claims 9 – 30 of the present Application map almost identically to claims 1 – 22 of '609.

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Claims 31 – 44 of the present Application map similarly to the mapping claims 1 – 8 above.

5. Claims 1 – 44 are rejected on the ground of nonstatutory obviousness-type double patenting as being unpatentable over claims 1 – 8 of U.S. Patent No. 6,401,112. Although the conflicting claims are not identical, they are not patentably distinct from each other because of the following mapping.

Claims 1 – 8 of the present Application map almost identically to claims 1 – 8 of '112.

Claim 9 of the present Application maps to claims 1 – 8 of '112.

Claim 10 of the present Application maps to claims 1 – 7 of '112.

Claim 11 of the present Application maps to claims 1, 2, 4, and 7 of '112.

Claim 12 of the present Application maps to claims 1 – 7 of '112.

Claim 13 of the present Application maps to claims 1, 2, 4, and 7 of '112.

Claim 14 – 44 of the present Application map similarly to the mapping of claims 9 – 13 above.

Claim Rejections - 35 USC § 102

6. The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

(e) the invention was described in (1) an application for patent, published under section 122(b), by another filed in the United States before the invention by the applicant for patent or (2) a patent granted on an application for patent by another filed in the United States before the invention by the

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applicant for patent, except that an international application filed under the treaty defined in section 351(a) shall have the effects for purposes of this subsection of an application filed in the United States only if the international application designated the United States and was published under Article 21(2) of such treaty in the English language.

7. Claims 31 – 44 are rejected under 35 U.S.C. 102(e) as being anticipated by Wright et al. (U.S. Pat. No. 5,857,201) (Enterprise Connectivity to Handheld Devices).

7.1 Regarding claim 31, Wright discloses a method for synchronizing messages on a portable computer with a personal computer, the method comprising:

detecting the personal computer connected to the portable computer (Fig. 4a; Abstract; col. 2, lines 43 – 49);

identifying a set of existing messages on the portable computer, the set of existing messages including an outgoing message (Figs. 4a, 4b; Abstract “The FL server can query the FL client database, add data to the client database, or remove data from the client database so as to make updates to both the client and server databases for reflecting changes that have happened on both sides since the last connection.”; col. 2, lines 43 – 59);

signaling the outgoing message to the personal computer for delivery to a mail server (Figs. 4a, 4b; Abstract; col. 2, lines 43 – 59);

receiving a set of incoming messages previously delivered to the personal computer (Figs. 4a, 4b; Abstract; col. 2, lines 43 – 59); and

comparing the set of existing messages with the set of incoming messages to identify differences between the set of existing messages and the set of incoming messages (Figs. 4a, 4b; Abstract; col. 5, lines 46 – 59).

7.2 Per claim 32, Wright teaches the method of claim 31, wherein detecting the personal computer includes detecting the personal computer across a serial port (Figs. 1, 2, 3; col. 4, lines 44 – 55).

7.3 Regarding claim 33, Wright discloses the method of claim 31, wherein identifying a set of existing messages includes identifying messages previously received from the personal computer (Figs. 1 – 3, 4a, 4b; Abstract; col. 5, lines 46 – 59).

7.4 Per claim 34, Wright teaches the method of claim 33, wherein identifying a set of existing messages includes identifying messages that were previously synchronized with the personal computer (Figs. 1 – 3, 4a, 4b; Abstract; col. 5, lines 46 – 59).

7.5 Regarding claim 35, Wright discloses the method of claim 31, wherein identifying a set of existing messages includes identifying messages received on the portable computer that were not previously synchronized with the personal computer (Figs. 1 – 3, 4a, 4b; Abstract; col. 5, lines 46 – 59).

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7.6 Per claim 36, Wright teaches the method of claim 31, wherein signaling the outgoing message to the personal computer for delivery to a mail server includes signaling a message composed on the portable computer to another end user (Figs. 1 – 3, 4a, 4b; Abstract; col. 5, lines 46 – 59).

7.7 Regarding claims 37 – 44, the rejection of claims 31 – 36 under 35 USC 102(e) (paragraphs 7.1 – 7.6 above) applies fully.

8. Any inquiry concerning this communication or earlier communications from the examiner should be directed to Kenneth R. Coulter whose telephone number is 571 272-3879. The examiner can normally be reached on 5 4 9.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Rupal Dharia can be reached on 571 272-3880. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

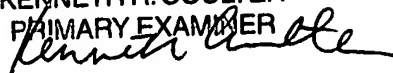
Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).

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KENNETH R. COULTER
PRIMARY EXAMINER

A handwritten signature in black ink, appearing to read "Kenneth R. Coulter", written over the printed name and title.

krc